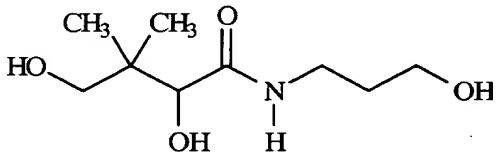
by the inclusion of panthenol (2,4-dihydroxy-N-(3-hydroxypropyl)-3,3-dimethyl butyramide) into a grooming composition. Panthenol has the formula:



and is commonly known by those of ordinary skill in the art as Vitamin B5. Wisotzki '545 is, therefore, directed to a Vitamin B5 containing shampoo.

The Examiner, in his rejection, has cited Wisotzki '545 as, "[teaching] a composition comprising water, an alcohol, a disaccharides, polymer (PVP) and benzyl quaternary ammonium compound." However, more germane to the issue of non-obviousness is the Examiner's admission, "The reference does not disclose the instant a) nm particle size and b) properties of the polymer – vapor transfer rate, transition temperature." Therefore, Wisotzki '545 teaches nothing which would suggest to make or to use the present invention, nor that there is a long felt need for the *system* of the present invention.

The Examiner states, "One of ordinary skill in the art would optimized [sic] the particle size through routine experimentation." Since nothing is taught in Wisotzki '545 which remotely relates to the subject matter of the present invention, Applicants suggest the artisan of ordinary skill would have a better chance of success if one started with a blank page rather than the "Vitamin B5" required teachings of the cited prior art. Starting at Wisotzki '545 would cause the artisan not only the requirement to derive the present invention, but to successfully de-construct the compositions disclosed therein.

The Federal Circuit has held ***In re Finish Engineering Co., Inc. v. Zerpa Industries, Inc.*, 806F2.d 1041, 1043, 1 USPQ2d 1114, 1116 (Fed. Cir. 1986)** "The determination whether prior art is analogous involves some factual issues concerning whether the reference is within the field of the inventor's endeavor or reasonably pertinent to the particular problem with which the invention was involved." Clearly the subject matter of Wisotzki '545 is outside the scope of the present invention. To make or to use the compositions of the present invention, one must have some knowledge that the compositions require a certain type of polymer. This teaching is wholly absent in Wisotzki '545. For this reason alone the cited prior art fails to establish a case of obviousness over the present invention.

The present invention requires (at page 2, line 25), "A polymer having a water vapor transfer rate of less than 10 g-mm/m^2-day and a glass transition temperature, T_g, greater than about 30 °C." Where in Wisotzki '545 is this taught? How much "routine experimentation" is necessary for these two critical parameters to be discovered and their boundaries established? In

no way does the cited prior art give the Formulator any suggestion that these two parameters are even in play, since they are not critical to the compositions disclosed by Wisotzki '545.

The Examiner's attention is directed to his remark that PVP is present in Wisotzki '545. PVP (polyvinyl pyrrolidone) does not have the glass transition temperature, T_g, nor the water vapor transpiration rate required by the compositions of the present invention. The only connection between the two is the term *polymer*.

The courts have ruled in the case of ***W.L. Gore & Associates, Inc. v. Garlock, Inc.* 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)** that a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. Using a polymer, *inter alia*, PVP, without regard to the properties thereof, teaches away from the strict requirements of the present polymers.

The courts have held that the relevant portions of a reference include not only those teachings which would suggest particular aspects of an invention (i.e., chemical ingredients and their properties) but also those teachings which would lead the artisan away from the claimed invention (i.e., the requirement that Vitamin B5 is present.). ***In re Lunsford,* 53 CCPA 986, 357 f.2d 380, 148 USPQ 716 (1966).** Using the Examiner's logic, one of ordinary skill in the art would look to a shampoo patent, recognize that if one took the steps of, a) ignoring the first required ingredient and its importance, b) look to an optional ingredient, polymers, and c) make the conclusion that if one restricted the water vapor transfer rate to less than 10 g-mm/m^2-day and a the glass transition temperature, T_g, to greater than about 30 °C, this could be the genesis of controlling the moisture transpiration rate of plants.

It is clear from ***In re Gordon,* 733 F.2d 900, 221 USPQ 1125 (Fed. Cir 1984)** that a lack of technological motivation for making a modification is evidence that the suggestion of omitting the Vitamin B5 and selecting a polymer having the required properties could not have come from the teachings of Wisotzki '545.

The Examiner also errs in confusing a "composition" with a "system" which is the subject matter of the present invention. The present invention relates to a system having a first component and a second component each of which comprises different ingredients and each of which is used in a different manner. Nowhere in the disclosure of the present invention is it taught that either of the two components can stand alone.

It is clear the Examiner has misconstrued the gist of the present invention. This is in evidence by his equating the term *composition* with the term *system*, which is the form of the present invention. It is also clear that the Examiner has cited nonanalogous art which is not only outside the endeavor of the present invention, but which teaches nothing remotely connected to the problem or solution thereof. It is clear the Examiner has cited this art only to find a prior art composition which comprises a polymer and a quaternary ammonium compound.

Reconsideration and withdrawal of the rejection to the Claims under 35 USC § 103(a) is therefore respectfully requested.

CONCLUSION

Applicants have made an earnest effort to place the present claims in condition for allowance. WHEREFORE, reconsideration of the claims as amended in light of the Remarks provided, withdrawal of the claims rejections, and allowance of Claims 1-28, as amended, are respectfully requested. In the event that issues remain prior to allowance of the noted claims, then the Examiner is invited to call Applicants' undersigned agent to discuss any remaining issues.

Respectfully submitted,

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